

REMARKS

In the June 9, 2006 Office Action, the Examiner noted that claims 1-18 were pending in the application; rejected claims 1, 2-7 and 12-14 under the second paragraph of 35 USC § 112; rejected claims 10, 11, 17 and 18 under 35 USC § 101; rejected claims 1-3, 8-12 and 15-18 under 35 USC § 102(e); and rejected claims 4-7, 13 and 14 under 35 USC § 103(a). In rejecting the claims, U.S. Patents 5,802,518 to Karaev et al. (Reference A in the June 9, 2006 Office Action); 6,717,938 to D'Angelo; and 6,563,517 to Bhagwat et al. (References B and C, respectively, in the May 6, 2005 Office Action) were cited. Claims 3, 5 and 7 have been canceled and thus, 1, 2, 4, 6 and 8-18 remain in the case. The rejections are traversed below.

Rejections under 35 USC § 112, Second Paragraph

In items 7-9 on pages 2-3 of the June 9, 2006 Office Action, 1, 2-7 and 12-14 were rejected under the second paragraph of 35 USC § 112, because the Examiner was unable to determine what "recipient information" means. It is submitted that one of ordinary skill in the art would have no difficulty understanding this term in context; however, to aid the Examiner, in each claim in which the term is introduced, the phrase "other recipient who generated the request" has been added. As this is the same meaning that one of ordinary skill in the art would have understood from the previous wording, it is submitted that this amendment does not affect patentability.

Withdrawal of the rejection under the second paragraph of 35 USC § 112 is respectfully requested. If this amendment is insufficient or there are any issues regarding indefiniteness or any other formal matters, the Examiner is respectfully requested to contact the undersigned by telephone prior to issuing another Office Action to arrange an Examiner Interview for the purpose of discussing further amendment of the claims to avoid another rejection that is not based on the prior art.

Rejections under 35 USC § 101

In items 11-12 on page 3 of the June 9, 2006 Office Action, claims 10, 11, 17 and 18 were rejected under 35 USC § 101 as allegedly directed to non-statutory subject matter. Although it is submitted that "computer-readable storage" is statutory subject matter, claims 10 and 11 have been amended to use the exact wording found in MPEP § 2106.IV.B.1(a).

Item 11 of the June 9, 2006 Office Action asserted that claims 17 and 18 "recite descriptive material that may or may not be an embodiment of a computer system or embodied

on a computer readable medium so as to be executable. However, claim 17 recites a "method for providing requested information to authorized recipients" (claim 17, lines 1-2). The comments in item 11 of the June 9, 2006 Office Action do not appear to be relevant to claims 17 and 18.

Item 12 of the June 9, 2006 Office Action asserted that the "'carrier through a line' embodiment is considered non-statutory as a signal encoded with functional descriptive material [that] does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101" (June 9, 2006 Office Action, page 3, lines 16-19). No basis in the law was cited for reviewing the specification to determine whether a method claim recites patentable subject matter, particularly in regard to a technique for transmitting a program that is considered not to be patentable subject matter. It is submitted that there is no legal basis for considering statements in the specification that do not relate to patentable subject matter in determining whether a claim is directed to patentable subject matter.

For the above reasons, withdrawal of the rejection under 35 USC § 101 is respectfully requested. If the Examiner disagrees, the Examiner is respectfully requested to contact the undersigned by telephone prior to issuing another Office Action to arrange an Examiner Interview for the purpose of discussing what, if any, further amendment of the claims is necessary to avoid another rejection under 35 U.S.C. § 101.

Rejections under 35 USC § 102

In items 14-16 on pages 4-6 of the June 9, 2006 Office Action, claims 1-3, 8-12 and 15-18 were rejected under 35 USC § 102(b) as anticipated by Karaev et al. The independent claims have been amended to incorporate limitations previously recited in claims 3, 5 and 7. In rejecting claim 3, column 3, lines 34-39 of Karaev et al. was cited as allegedly disclosing that "the provision format includes a portable document format which is converted from provision information and an original format which is not converted from provision information" (Office Action, page 5, lines 6-8).

As indicated in the portion of column 3 cited in rejecting claim 3, Karaev et al. discloses a system in which "files received from the contributor work stations are converted at a central site into [a] predetermined format" (column 3, lines 34-35). This is not what was recited in claims 3, 5 and 7 and is now recited in the independent claims. Unlike the system disclosed by Karaev et al. in which the contributors have no control over the formatting of their documents, the independent claims recite "the provision format including a portable document format which is converted from provision information and an original format which is not converted from provision informa-

tion" (e.g., claim 1, line 7-9). Claim 1 recites "accepting, by one terminal device, ... a provision format of said provision information to be applied to said recipient" (claim 1, lines 5-7). In other words, both the portable document format and the original format are provided as "the provision format" for a specific recipient. No suggestion has been found in Karaev et al. that anyone other than an administrator of the "central site" (column 3, line 35) has control over the format into which files are converted.

Furthermore, in rejecting claim 1, it was asserted that "accepting ... a provision format of said provision information to be applied to said recipient" (claim 1, lines 5-7) was disclosed at column 6, lines 21-43). However, this portion of Karaev et al. only describes how "the contributor completes a form relating to the report" (column 6, lines 21-22). The "form" is described as "a document profile ... displayed on the screen of the contributor workstation" (column 6, lines 16-17). The only details of what is included on the form that has been found is that the

form has fields relating to the report, for example, title, author, subject, date and time creation, distribution level (setting distribution to a default group of investors or one of a set of predefined groups of investors) and expiration time. Optionally, the contributor can enter additional information in the form, such as, for example, ticker symbol, industry group, synopsis, country, region, currency, etc.

(column 6, lines 29-35). No suggestion has been found in Karaev et al. that either the contributor or a recipient can specify, "a portable document format which is converted from provision information" as recited in all of the independent claims.

For the above reasons, it is submitted that independent claims 1, 2, 8-12 and 15-17, as well as claim 18 which depends from claim 17, patentably distinguish over Karaev et al.

Rejections under 35 USC § 103

In items 18-21 on pages 6-8 of the June 9, 2006 Office Action, claims 4, 5 and 13 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of the D'Angelo. Claim 4 depends from claim 2, claim 13 depends from claim 12 and claim 5 has been canceled. Nothing was cited or has been found in D'Angelo suggesting modification of Karaev et al. to overcome the deficiencies of Karaev et al. discussed above. Therefore, it is submitted that claims 4 and 13 patentably distinguish over the combination of Karaev et al. and D'Angelo for the reasons discussed above with respect to claims 2 and 12.

In items 22-25 on pages 8-10 of the June 9, 2006 Office Action, claims 6, 7 and 14 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of Bhagwat et al. Claim 6 depends from claim 2, claim 14 depends from claim 12 and claim 7 has been canceled. Nothing was cited or has been found in Bhagwat et al. suggesting modification of Karaev et al.

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to restrict access by format of information provided to users. Therefore, it is submitted that claims 6 and 14 patentably distinguish over Karaev et al. in view of Bhagwat et al. for at least the reasons discussed above with respect to claims 2 and 12.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1, 2, 4, 6 and 8-18 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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